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PATENT
CUSTOMER NUMBER 22,852
Attorney Docket No. 01064.0011-07000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard LEVY)
Serial No.: 09/779,588) Group Art Unit: 1714
Filed: February 9, 2001) Examiner: M. Medley
For: LUBRICANT COMPOSITIONS)
AND METHODS)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. §1.192

Appellant submits this brief on appeal in triplicate, setting forth the authorities and arguments on which appellant relies to maintain the appeal. The fee required by 37 C.F.R. § 1.17(c) accompanies this brief.

(1) Real Party in Interest

The inventor assigned the parent application, Serial No. 08/487,436 filed June 7, 1995 to Lee County Mosquito Control District, recorded at Reel 7878 Frame 06020 on August 23, 1995 which makes Lee County Mosquito Control District the real party in interest.

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(2) Related Appeals and Interferences

Appellant has two appeals before the Board of Patent Appeals and Interferences in related applications, Serial No. 08/943,125 filed October 3, 1997 and Serial No. 08/943,123 filed October 3, 1997. Appellant has not been informed if either application is involved in an interference, but the Patent and Trademark Office has labeled the cover of their file for Application Serial No. 08/943,125 as follows:

U. S. PATENT AND TRADEMARK OFFICE

RETURN TO (PTO1056)

INTERFERENCE SERVICE BRANCH

This case is involved in an
Interference Proceeding

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The Board's decision in the pending appeal could directly affect, or be directly affected by, or have a bearing on the decision in the co-pending appeals.

Appellant calls the Board's attention to the United States Patent Application of Martin C. Flautt et al. Serial No. 09/190,866 filed November 13, 1998. Appellant advised the Examiner that the present application copies claims from the corresponding Flautt et al. PCT Application WO 00/29486. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference in this application

(3) Status of Claims

Claims 57-68 remain pending for the purpose of this appeal. Appellant has not amended claims 57-68.

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(4) Status of Amendments

Appellant has not amended the application.

(5) Summary of Invention

The invention comprises a coating formed on the surface of a substrate, where the coating comprises a superabsorbent polymer further comprising a lubricant (written description, p. 20). The superabsorbent polymer absorbs greater than 100 times its weight in water (written description, p. 22, and claim 2 as originally filed) and desorbs water when the coating is dried (written description, pp.31, 32). The substrate may also comprise a cable, or a wire (written description, pp. 6-9 lubricants, p. 12 lubricants on cables, p. 6 lubricants on wire). The invention also relates to a product produced by the process of combining the superabsorbent polymer with the lubricant. The coating may also contain a viscosity modifying agent (written description, par. bridging pp. 10-11, and pp.11, 12, and 20) and/or a binder (written description, par. bridging pp. 17-18, pp.18, 19, 20, and 21).

(6) Issues

The appeal presents the issues of whether the Examiner properly rejected the claims under 35 U.S.C. § 112 first paragraph.

(7) Grouping of Claims

Claims 57-68 do not stand or fall together. Appellant will demonstrate the separate patentability of the claims in the subsequent Argument.

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(8)(a) Argument

The Rejection of Claims 57-68 Under 35 U.S.C. § 112 First Paragraph

In the first full paragraph on page 2 of the October 23, 2001 communication from the Examiner, she rejects claims 57-68 under 35 U.S.C. § 112 first paragraph. The Examiner takes the position that the written description, did not reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention.

The Examiner also rejected the application on the grounds that the appellant did not have support for the combination of appellant's lubricant on a wire or cable substrate, and even though specifically describing the invention (page 20, second paragraph) as comprising "a method of lubricating a surface comprising coating the surface with a lubricating composition comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces" (i.e., a "lubricant"), the appellant did not provide support for a process of lubricating a surface.

In the following discussion, appellant will show he had possession of the invention, how the terms of the claims on appeal find support in the specification as filed (i.e., the written description and original claims) and why persons with ordinary skill in the art to which the claimed invention pertains would have instructions how to make and use the invention.

Appellant will thereby demonstrate, as required by 37 C.F.R. § 1.192(c)(8)(i)(A), (B), and (C) the errors in the rejection and how appellant has complied with the first paragraph of 35 U.S.C. § 112, specifically showing how the written description describes the subject matter defined by each of the rejected claims, and enables any

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person skilled in the art to make and use the subject matter defined by each of the rejected claims, as well as setting forth the best mode contemplated by the inventor for carrying out the invention.

The Examiner has taken the position that when the appellant says he has lubricated a surface with a lubricant coating he hasn't described a lubricant coating on a surface, but only a method of lubrication. Appellant requests the Examiner to explain how conducting the process of applying a lubricant coating to a surface does not result in obtaining a surface with a lubricant coating.

The written description clearly shows appellant had possession of the invention now claimed, as page 20, inter alia, makes clear. This describes the invention as comprising a lubricant composition of matter comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces, which is a lubricant both generally and specifically described in the written description (see page 20, first paragraph). Page 20 , second paragraph, also describes the invention as comprising a method of lubricating a surface comprising coating the surface with a lubrication composition comprising a superabsorbent polymer combined with the material for decreasing friction between moving surfaces.

Pages 6-19 of the written description describe these various lubricants which include petroleum lubricants (and lubricant additives), synthetic lubricants, greases, solid lubricants and metal working lubricants. This part of the written description also states that these lubricants are used on cables (page 12, penultimate paragraph) and wire (page 16, second full paragraph and page 17, first paragraph) as well as in automobile engines, high speed machinery, high pressure hydraulic systems, torque

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convertors, aircraft engines, turbine engines, steam engines, steam turbines, electric motors, hydraulic systems, die casting machines, furnace controls, electric welders, navy hydraulic catapults, electric transformers, refrigerator compressors, die lubricants, metal working molds, oxygen equipment, airframe lubrication, nuts, bolts, screws and gears. These comprise only some of the substrates coated with appellant's lubricant composition.

In specifically rejecting the claims, the "Examiner did not find any explicit disclosure for claim 61 'the substrate comprises a cable. . . .'" (October 23 Office Action, p. 3.) Appellant's disclosure, however, supports claim 61. The invention comprises applying the claimed lubricant composition to a substrate as well as the article of manufacture obtained. Page 20 of the written description states that appellant's lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description, which include those described at pages 6 -19. The lubricants described at page 12 in this regard are used in cables (written description, page 12, line 6 from the bottom). The application therefore supports claim 61 directed to the lubricant of the invention on a substrate where the substrate comprises a cable.

The Examiner also did not find any explicit disclosure "for 'claim 62 [where] the substrate comprises a wire.'" (October 23 Office Action, p. 3.) The written description describes a coating comprising a superabsorbent polymer further comprising a lubricant applied to a wire substrate at page 16, line 8 from the bottom, page 17, line 5 and page 47, line 8 from the bottom.

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The Examiner also did not find any explicit disclosure for the claim 58 parameter wherein the superabsorbent polymer absorbs greater than 100 times its weight in water. (October 23 Office Action, p. 3.) The written description at page 22, line 2 from the bottom discloses this parameter as does claim 2 as originally filed.

The Examiner also did not find any explicit disclosure for the claim 58 parameter that the superabsorbent polymer desorbs water when the coating is dried. (October 23 Office Action, p. 3.) The written description page 31, first and second full paragraphs and penultimate paragraph, and the paragraph bridging pages 31 and 32 support this aspect of claim 58.

Pages 31 and 32 in this regard describe a method of combining the superabsorbent polymer with the lubricant and additives, when employed, by using water or high humidity (80% R. H.) to swell the superabsorbent followed by placing the composition obtained in a 27-38% R. H. environment to remove substantially all of the water introduced in the first part of the process. The superabsorbent polymer clearly desorbs water upon drying.

The Examiner rejects claims 57-68 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly concerned to make and/or use the invention. (October 23 Office Action, p. 4). This rejection repeats the October 3, p. 3 rejection.

Appellant incorporates by reference the previous response in this Brief on Appeal to the 35 U.S.C. §112, first paragraph rejection which shows appellant had possession of the claimed invention at the time of filing the instant application relative to

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not only the coating formed on the surface of a substrate (claim 57), but also the superabsorbent polymer that absorbs greater than 100 times its weight in water and desorbs water when the coating is dried (claim 58), the coated cable (claim 61), and the substrate comprising a wire (claim 62).

The Claims Do Not Stand Or Fall Together

The Examiner did not reject the claims under 35 U.S.C. § 102 or 35 U.S.C. §103, and has not shown or argued that the claims do not contain patentably distinct subject matter.

Generic claim 57 relates to a coating formed on the surface of a substrate where the coating comprises a superabsorbent polymer further comprising a lubricant. Claim 58, dependent on claim 57, further describes the superabsorbent polymer as capable of absorbing greater than 100 times its weight in water and which also desorbs water upon drying the coating. Appellant should have the flexibility of claiming the generic and subgeneric class of superabsorbent polymers of claims 57 and 58.

Similarly, the appellant should be entitled to claim the differences between the coating compositions of claims 59 and 63, and 60 and 64 which comprise coating compositions having a viscosity modifying agent as compared to coatings that do not, and similarly the coating of claim 59 which contains a binder.

Appellant should also have the leeway to claim the coating of claim 61 on a substrate comprising a cable as well as the coating of claim 62 on a substrate comprising a wire. Appellant should be entitled to claim the invention of claims 65, 66 and 68 as a product by process in view of the decision of the Court of Appeals for the

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Federal Circuit in Exxon v. Lubrizol, 64 F.3d 1553, 35 U.S.P.Q. 2d, 1801 (Fed. Cir. 1995), where the court in deciding the infringement of a lubricant composition found the various claimed components of the composition reacted with one another when combined and formed new materials, so that the plaintiff could not prove infringement since the patent did not claim the new materials, but indicated in dicta that had the patent included product by process claims, the plaintiff would have prevailed. The present application also relates to lubricant technology and appellant claims the invention as a product produced by a process in view of the Exxon decision.

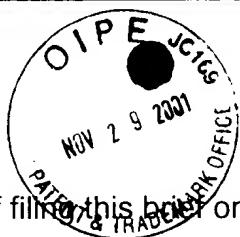
Conclusions

Appellant submits that the Examiner has not made a viable rejection under 35 U.S.C. § 112, first paragraph, for all the reasons set forth above. The Examiner has not shown that the appellant was not in possession of the invention at the time he filed the application, nor has she shown how the written description fails to support the claims, nor in what way the written description fails to provide instructions to a person with ordinary skill in the lubricating art how to make and use the invention.

Appellant therefore requests the Board to reverse the Examiner in all respects, and remand the application to the Examiner, either for the purposes of declaring an interference with Flautt et al., or for the issuance of a notice of allowance.

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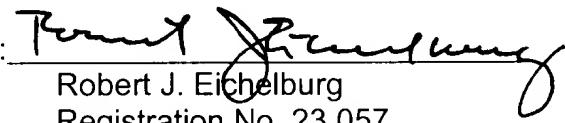
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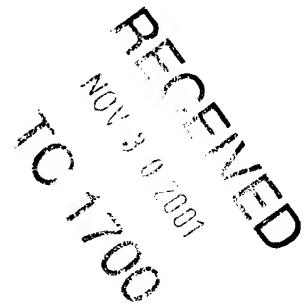
If filing this brief on appeal requires an extension of time pursuant to 37 C.F.R. §1.136 and payment of an extension fee or other fee, any of which this brief does not account for, appellant's attorneys request such an extension and charging any fees due to their deposit account number 06-0916.

Respectfully submitted,

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By: 
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Dated: November 29, 2001



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(9) Appendix

This following appendix contains a copy of the claims involved in the appeal.

- 57. A coating formed on the surface of a substrate, said coating comprising a superabsorbent polymer further comprising a lubricant.
- 58. The coating of claim 57 wherein the superabsorbent polymer absorbs greater than 100 times its weight in water and desorbs water when the coating is dried.
- 59. The coating of claim 57 further comprising a viscosity modifying agent.
- 60. The coating of claim 58 further comprising a viscosity modifying agent.
- 61. The coating of claim 57 wherein the substrate comprises a cable.
- 62. The coating of claim 57 wherein the substrate comprises a wire.
- 63. The coating of claim 61 further comprising a viscosity modifying agent.
- 64. The coating of claim 62 further comprising a viscosity modifying agent.

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65. The coating of any one of claims 57, 58, 61 or 62 wherein the coating comprises a product made by the process of combining said superabsorbent polymer with said lubricant.

66. The coating of any one of claims 59, 63 or 64 where said coating comprises a product produced by the process of combining said superabsorbent polymer, lubricant and viscosity modifying agent.

67. The coating of any one of claims 57-64 further comprising a binder.

68. The coating of claim 67 wherein said coating comprises a product produced by the process of combining said superabsorbent [superabosrbent] polymer, said lubricant and said binder, and said viscosity modifying agent when present.

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